



[10191/4578]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Wolfgang PFEIFERL et al.

For: TORQUE CONTROL ELEMENT  
FOR A STEERING SYSTEM  
IN A MOTOR VEHICLE

Filed: May 5, 2006

Serial No.: 10/578,338

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APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

SIR:

In the above-identified patent application ("the present application"), Appellants mailed a Notice Of Appeal on June 16, 2009 as to the Final Office Action issued by the U.S. Patent and Trademark Office on January 26, 2009, so that the two-month appeal brief due date is August 16, 2009 (since the Notice of Appeal was e-filed in the Office on June 16, 2009).

In the Final Office Action, claims 13 to 35 were finally rejected.

An Amendment After A Final Office Action was mailed on April 27, 2009 (and filed on April 30, 2009), and an Advisory Action was mailed on May 14, 2009.

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner.

*The Appeal Brief is believed to comply with all the requirements of Rule 41.37. It is noted that the "concise explanation" language of the Rule is like the "concise explanation"*

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*requirement of former Rule 37 CFR 1.192, and that the length of the concise explanation provided herein should therefore be acceptable, since the format was acceptable under 37 CFR 1.192 and since it specifically defines the subject matter of the relevant claims involved in the appeal. AARON C. DEDITCH (reg. no. 33,865) has filed many appeal briefs, the concise explanation for which has ultimately always been accepted by the Patent Office. The Office is encouraged to contact the undersigned if there are any questions as to the description of the claimed subject matter.*

*It is noted that the Patent Office Rules do not require the Applicants to include references cited by and relied upon by the Examiner in the Evidence Appendix (although it is required by the Office for the Examiner). In the present Appeal, the Applicants have not submitted any evidence on which they intend to rely, so that the Evidence Appendix lists no evidence.*

It is respectfully submitted that this Appeal brief complies with 37 C.F.R. 41.37. Although no longer required by the rules, this Brief is submitted in triplicate as a courtesy to the Appeals Board.

It is respectfully submitted that the final rejections of pending and considered claims 13 to 35 should be reversed for the reasons explained below.

**1. REAL PARTY IN INTEREST**

The real party in interest in the present appeal is Robert Bosch GmbH ("Robert Bosch") of Stuttgart in the Federal Republic of Germany. Robert Bosch is the assignee of the entire right, title and interest in the present application.

**2. RELATED APPEALS AND INTERFERENCES**

There are no interferences or other appeals related to the present application, which "will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal".

**3. STATUS OF CLAIMS**

**CLAIMS 1 TO 12 ARE CANCELED.**

A. Claims 13 to 16 and 18 stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,208,923 ("Hommel").

B. Claims 13, 17, 19, 20, and 22 to 24 stand rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the Hommel reference in view of U.S. Patent No. 6,904,346 ("Higashi").

C. Claims 13 to 20 and 22 to 35 stand rejected under 35 U.S.C. § 103 as unpatentable over German Patent No. DE 101 14 600 ("Rieth"), in view of U.S. Application No. 2002/0166716 ("Shimizu").

D. Claim 21 stands rejected under 35 U.S.C. § 103 as unpatentable over the Hommel reference in view of the Higashi reference, in further view of U.S. Patent Application no. 2005/0082108 ("Husain").

Appellants therefore appeal from the final rejections of pending claims 15 to 35. A copy of all of the pending and appealed claims 15 to 35 is attached hereto in the Appendix.

**4. STATUS OF AMENDMENTS**

In response to the Final Office Action mailed on January 26, 2009, a Response After A Final Office Action was mailed on April 27, 2009 (and filed on April 30, 2009) in response to the Final Office Action, and an Advisory Action was mailed on May 14, 2009.

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner, and that the Response After Final does not require entry since it included no amendments.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

*The claimed subject matter is described as follows, and is directed to addressing the following problems and/or providing the following benefits, and as described in the context of the present application.*

The presently claimed subject matter relates generally to a torque control element for a steering system in a motor vehicle. The torque control element includes at least two electrical units, each of the electrical units being assigned a separate power supply unit, connected via at least one fuse. (See specification, e.g., Abstract).

Independent claim 13 is to a torque control element for controlling a steering system in a motor vehicle. (See specification, page 1, lines 2 to 4, and page 2, lines 29 to 31.) The system includes at least two electrical units, (see specification, page 2, line 33 to page 3, line 2), and further includes power supply units, each of the electrical units being assigned a respective one of power supply units. (See specification, page 1, lines 2 to 4, and page 2, lines 29 to 31.) Further, each of the electrical units are connected via at least one fuse and operate independently of one another. (See specification, page 3, lines 4 to 8.)

Independent claim 19 is to a steering system that includes a first and a second torque control element. (See specification, page 4, lines 33 to 34.) Each of the first and second torque control elements include at least two electrical units. (See e.g., specification, page 2, line 33 to page 3, line 2, and Abstract.) The steering system further includes power supply units that are each assigned a respective power supply unit, and each is connected via at least one fuse. (See specification, page 2, line 32 to page 3, line 6, page 3, line 33 to page 4, line 3; and Abstract.) The first torque control element is a manual-torque control element for a steering handle, and the second torque control element is a wheel-torque control element for at least one steered vehicle wheel. (See specification, page 4, lines 14 to 16 and line 33 to page 5, line 4.)

As to claim 14 (depends from claim 13), it also includes the feature in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate

with each other. (*See* specification, page 3, lines 20 to 21, and page 3, line 33 to page 4, line 3.)

As to claim 15 (depends from claim 14), it includes the feature in which the processing unit and the output-stage unit of at least one of the electrical units are connected to one of the fuses to the power supply unit assigned to the electrical unit. (*See* specification, page 3, line 33 to page 4, line 3.)

As to claim 16 (depends from claim 14), it includes the feature in which at least one sensor for monitoring a steering device is assigned to the processing unit, and at least one actuator to control the steering device is assigned to the output-stage unit. (*See* specification, page 4, lines 5 to 8, page 10, lines 5 to 9, and Figs. 1 to 6.)

As to claim 20 (depends from claim 19), it includes the feature in which the steering handle and the at least one steered vehicle wheel are connected to each other via an electronic controlled system. (*See* specification, page 5, lines 10 to 13, page 9, lines 1 to 9, and Figs. 1 to 6.)

As to claim 22 (depends from claim 19), it includes the feature in which all electrical units are accommodated in a single housing. (*See* specification, page 7, lines 24 to 26.)

As to claim 23 (depends from claim 19), it includes the feature in which the electrical units of each torque control element are accommodated in one housing. (*See* specification, page 7, lines 24 to 26.)

As to claim 24 (depends from claim 19), it includes the feature in which each of the electrical units is accommodated in a separate housing. (*See* specification, page 4, lines 23 to 24, and page 7, lines 26 to 27.)

As to claim 25 (depends from claim 19), it includes the feature in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other. (*See* specification, page 3, lines 20 to 21, and page 3, line 33 to page 4, line 3.)

As to claim 26 (depends from claim 25), it includes the feature in which the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit. (*See* specification, page 3, line 33 to page 4, line 3.)

As to claim 27 (depends from claim 25), it includes the feature in which at least one sensor to monitor a steering device is assigned to the processing unit, and at least one actuator



to control the steering device is assigned to the output-stage unit. (See specification, page 4, line 5 to 8, and page 10, lines 5 to 9, and Figs. 1 to 6.)

As to claim 30 (depends from claim 19), it includes the feature in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other. (See specification, page 3, lines 20 to 21, and page 3, line 33 to page 4, line 3.) The processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit. (See specification, page 3, line 33 to page 4, line 3.) At least one sensor to monitor a steering device is assigned to the processing unit, and at least one actuator to control the steering device is assigned to the output-stage unit. (See specification, page 4, lines 5 to 8, page 10, lines 5 to 9, and Figs. 1 to 6.)

As to claim 33 (depends from claim 13), it includes the feature in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other. (See specification, page 3, lines 20 to 21, and page 3, line 33 to page 4, line 3.) Further, the processing unit and the output-stage unit of at least one of the electrical units are connected to one of the fuses to the power supply unit assigned to the electrical unit. (See specification, page 3, line 33 to page 4, line 3.) Further, at least one sensor to monitor a steering device is assigned to the processing unit, and at least one actuator to control the steering device is assigned to the output-stage unit. (See specification, page 4, line 5 to 8, and page 10, lines 5 to 9, and Figs. 1 to 6.)

Finally, the appealed claims include no means-plus-function language and no step-plus-function claims, so that 41.37(v) is satisfied as to its specific requirements for such claims, since none are present here. Also, the present application does not contain any step-plus-function claims because the method claims in the present application are not "step plus function" claims because they do not recite "a step for," as required by the Federal Circuit and as stated in Section 2181 of the MPEP.

**6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 13 to 16 and 18 were properly rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,208,923 (“Hommel”).

B. Whether claims 13, 17, 19, 20, and 22 to 24 were properly rejected under 35 U.S.C. 103(a) over the combination of the Hommel reference in view of U.S. Patent No. 6,904,346 (“Higashi”).

C. Whether claims 13 to 20 and 22 to 35 were properly rejected under 35 U.S.C. § 103(a) over German Patent No. DE 101 14 600 (“Rieth”), in view of U.S. Application No. 2002/0166716 (“Shimizu”).

D. Whether claim 21 was properly rejected under 35 U.S.C. § 103(a) over the Hommel reference in view of the Higashi reference, in further view of U.S. Patent Application no. 2005/0082108 (“Husain”).

**7. ARGUMENTS**

**A. REJECTIONS UNDER 35 U.S.C § 103(A)  
OF CLAIMS 13 to 16 & 18**

Claims 13 to 16 and 18 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,208,923 (“Hommel”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct.

1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

### **CLAIMS 13 & 18**

It is respectfully submitted that the Hommel reference does not disclose (nor even suggest) the claim 13 feature of “at least two electrical units; and power supply units, each of the electrical units being assigned a respective one of power supply units, and each being connected via at least one fuse,” as provided for in the context of the presently claimed subject matter. The Final Office Action concedes this critical deficiency. (*Final Office Action*, paragraph 3).

It is respectfully submitted that the Hommel reference only concerns a “fault mode” system which deals with malfunctions in the system, so that if a fault occurs, “the system in which the fault has occurred is shut down.” (Hommel, column 3, lines 53 to 56). Accordingly, one skilled in the art would not be motivated to modify the Hommel reference as suggested in the Final Office Action. This is because Hommel has a “fault mode” that addresses malfunctions, which makes fuses redundant at best.

Further, the Final Office Action has not provided any proper support for the proposition that there would be a reasonable expectation of success for the proposed modification of the Hommel reference. In this regard, by disabling power (via fusing its power supply) to the electronic components of the Hommel system (as suggested by the Final Office Action), it may prevent the “fault mode” from shutting down the defective components.

Indeed, it is respectfully submitted that one skilled in the art would not have any motivation to modify the Hommel reference as suggested by the Final Office Action. This is because it may even defeat the purpose and intent of the “fault mode.” A *prima facie* obviousness cannot be established based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, since there is no



suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

As further regards the obvious rejection, the Hommel reference does not disclose (nor suggest) the claim 13 feature in which “at least two electrical units operate independently of one another,” as provided for in the context of the presently claimed subject matter. With the process computer of the Hommel reference, “[i]n the event of a fault, the process computer of one system shuts down the other system via no-current-opening relays.” (Hommel, column 1, lines 64 to 67 (emphasis added)). Thus, there is reciprocal influencing of the two systems. For example, a fault within one system can have an effect on the other system, and can therefore affect the functioning of the entire steering system. Therefore, the electrical units don’t operate independently of one another, as provided for in the context of the claimed subject.

For at least the foregoing reasons, claim 13, and its dependent claim 18, are allowable. Withdrawal of the obviousness rejections of claims 13 and 18 is therefore respectfully requested.

#### **CLAIMS 14 & 15**

Claims 14 and 15 depend from claim 13 and are allowable for at least the same reasons as claim 13.

Still further, the subject matter of claim 14 (which depends from claim 13) further includes the feature *in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other*. The subject matter of claim 15 (which depends from claim 14) further includes the feature *in which the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit*. Any review of the Hommel reference makes plain that the above highlighted features are not disclosed, nor suggested.

In this regard, the Office has not even provided any supporting citation to reject claims 14 and 15. Indeed the Office has not even addressed the feature of an *output-stage unit cooperating with a processing unit and connected in each case via one of the fuses to the power supply unit*, as provided for in the context of claims 14 and 15 accordingly. Since the Office has not cited any specific section of the applied reference to support the obviousness

rejections of claims 14 and 15, it is respectfully submitted that a *prima facie* case of obviousness has not been made by the Examiner.

For at least the foregoing reasons, claims 14 and 15 are allowable. Withdrawal of the obviousness rejections of claims 14 and 15 is therefore respectfully requested.

#### **CLAIM 16**

Claim 16 ultimately depends from claim 13 and is therefore allowable for at least the same reasons as claim 13.

Still further, the subject matter of claim 16 (which depends from claim 14) further includes the feature *in which at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit*. Any review of the Hommel reference makes plain that the above highlighted features are not disclosed, nor suggested.

In this regard, it is respectfully submitted that the Office has not even addressed the feature of an *output-stage unit* which has assigned to it at least one actuator configured to control the steering device, as provided for in the context of claim 16. Since the Office has not cited any specific section of the applied reference to support the obviousness rejection of claim 16 as to the feature of the *output-stage unit*, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

For at least the foregoing reasons, claim 16 is allowable. Withdrawal of the obviousness rejection of claim 16 is therefore respectfully requested.

#### **B. REJECTIONS UNDER 35 U.S.C § 103(A) OF CLAIMS 13, 17, 19, 20 & 22 TO 24**

Claims 13, 17, 19, 20, and 22 to 24 were rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the Hommel reference in view of U.S. Patent No. 6,904,346 ("Higashi").

#### **CLAIMS 13 & 17**

Claim 13 is allowable for essentially the same reasons as provided in the context of the obviousness discussion of the Hommel reference. This is because the secondary Higashi

reference does not cure -- and is not asserted to cure -- the critical deficiency of the primary Hommel reference. Accordingly, claim 13 is allowable, as is its dependent claim 17.

Withdrawal of the obviousness rejections of claims 13 and 17 is therefore respectfully requested.

#### **CLAIM 19**

Claim 19 includes features like those of claim 13 and is therefore allowable for essentially the same reasons as claim 13, since the secondary Higashi reference does not cure -- and is not asserted to cure -- the critical deficiency of the primary Hommel reference.

Withdrawal of the obviousness rejection of claim 19 is therefore respectfully requested.

#### **CLAIM 20**

Claim 20 depends from claim 19 and is therefore allowable for at least the same reasons as claim 19.

Still further, the subject matter of claim 20 (which depends from claim 19) further includes the feature *in which the steering handle and the at least one steered vehicle wheel are connected to each other via an electronic controlled system*. Any review of the Hommel and Higashi references makes plain that the above highlighted features are not disclosed, nor suggested.

In this regard, it is respectfully submitted that the Office has not even provided any supporting citation to reject claim 20. Indeed, the Office has not addressed the above highlighted features at all. Since the Office has not cited any specific section of the applied references to support the obviousness rejection of claim 20, it is respectfully submitted that a *prima facie* case of obviousness has not been made by the Office.

For at least the foregoing reasons, claim 20 is allowable. Withdrawal of the obviousness rejection of claim 20 is therefore respectfully requested.

#### **CLAIMS 22 to 24**

Claims 22 to 24 depend from claim 19 and are therefore allowable for at least the same reasons as claim 19.

Still further, the subject matter of claim 22 further includes the features *in which all electrical units are accommodated in a single housing, and in which the electrical units of each torque control element are accommodated in one housing*, as provided for in the context of the presently claimed subject matter. The subject matter of claim 24 further includes the feature *in which each of the electrical units is accommodated in a separate housing*. Any review of the Hommel and Higashi references makes plain that the above highlighted features are not disclosed, nor suggested. The Final Office Action conclusorily asserts that:

[The] electrical units *can be accommodated* in a housing or two housings *depending of the space available* in the vehicle; for example: *if space is not an issue*, the housing *can be big enough* to accommodate both electrical units, or *if the space is reduced*, the electrical units *can be split into two* housing in order to make use of all the *space available*.

(Final Office Action, page 3, paragraph 4, emphasis added).

It is respectfully submitted that whether there is *sufficient room* for certain units is not the issue. Rather, the issue is whether the applied references disclose or suggest all of the respective claim features. In this regard, the Office has not cited any specific section of the applied references to support the obviousness rejections of claims 22 to 24. Instead, it has conclusorily asserted that a certain “housing can be big enough to accommodate” certain units. Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

For at least the foregoing reasons, claims 22 to 24 are allowable. Withdrawal of the obviousness rejections of claims 22 to 24 is therefore respectfully requested.

**C. REJECTIONS UNDER 35 U.S.C § 103(A)  
OF CLAIMS 13 to 20 & 22 to 35**

Claims 13 to 20 and 22 to 35 were rejected under 35 U.S.C. § 103 as being unpatentable over German Patent No. DE 101 14 600 (“Rieth”), in view of U.S. Application No. 2002/0166716 (“Shimizu”).

**CLAIMS 13 to 18**

It is respectfully submitted that the Rieth reference does not disclose (nor suggest) the claim 13 feature in which the “at least two electrical units operate independently of one another.” In this regard, the Final Office Action has not even addressed this claim feature. In fact, the Final Office Action has not identified any section of the references (including the Rieth reference) that even discusses the feature in which at least two electrical units operate independently of one another, as provided for in the context of the claimed subject matter. As to the secondary Shimizu reference, it does not cure -- and is not asserted to cure -- this critical deficiency.

For at least this reason, claim 13 is allowable, as are its dependent claims 14 to 18. Withdrawal of the obviousness rejections of claims 13 to 18 is therefore respectfully requested.

**CLAIMS 19, 20, 22 to 24, 28 to 29, 31 & 32**

Claim 19 includes the features in which “the first torque control element is a manual-torque control element for a steering handle, and the second torque control element is a wheel-torque control element for at least one steered vehicle.” The Hommel reference does not disclose (nor suggest) all of these features. In fact, the Final Office Action concedes that “Hommel mentioned above fails to disclose a manual torque element for a steering handle.” (*Final Office Action*, page 3, paragraph 4). As to the Higashi reference, it simply does not cure this critical defect since there is no proper support for the assertions of the Final Office Action, as any review of the applied reference makes plain. Accordingly, claim 19 is allowable, as are its dependent claims.

It is therefore respectfully requested that the obviousness rejections of claims 19, 20, 22 to 24, 28 to 29, 31 and 32 be withdrawn.

**CLAIMS 25 & 26**

Claims 25 and 26 depend from claim 19 and are therefore allowable for at least the same reasons as claim 19.

Still further, the subject matter of claim 25 (which depends from claim 13) further includes the feature *in which at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other*. The subject matter of claim 26 (which



depends from claim 25) further includes the feature *in which the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit*. Any review of the Rieth and Shimizu references makes plain that the above highlighted features are not disclosed, nor suggested.

In this regard, the Office has not even provided any supporting citation in the rejections of claims 25 and 26. Indeed the Office has not even addressed the feature of an *output-stage unit cooperating with a processing unit and connected in each case via one of the fuses to the power supply unit*, as provided for in the context of claims 25 and 26. Since the Office has not cited any specific section of the applied reference to support the obviousness rejection of claims 25 and 26, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

For at least the foregoing reasons, claims 25 and 26 are allowable. Withdrawal of the obviousness rejections of claims 25 and 26 is therefore respectfully requested.

#### **CLAIM 27**

Claim 27 ultimately depends from claim 19 and is therefore allowable for at least the same reasons as claim 19.

Still further, the subject matter of claim 27 (which depends from claim 25) further includes the feature *in which at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit*. Any review of the Rieth and Shimizu references makes plain that the above highlighted features are not disclosed, nor suggested.

In this regard, it is respectfully submitted that the Office has not even addressed the feature of an *output-stage unit*, let alone one which has assigned to it at least one actuator which controls the steering device, as provided for in the context of claim 27. Since the Office has not cited any specific section of the applied reference to support the obviousness rejection of claim 27 as to the feature of *output-stage unit*, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

For at least the foregoing reasons, claim 27 is allowable. Withdrawal of the obviousness rejection of claim 27 is therefore respectfully requested.

**CLAIM 30**

Claim 30 depends from claim 19 and is therefore allowable for at least the same reasons as claim 19.

Still further, the subject matter of claim 27 (which depends from claim 19) further includes features similar to those of claims 25, 26, and 27, and is therefore allowable for essentially the same reasons as claims 25, 26, and 27.

Withdrawal of the obviousness rejection of claim 30 is therefore respectfully requested.

**CLAIM 33**

Claim 33 depends from claim 13 and is therefore allowable for at least the same reasons as claim 13.

Still further, the subject matter of claim 33 (which depends from claim 13) further includes features similar to those of claims 14, 15, and 16, and is therefore allowable for essentially the same reasons as claims 14, 15, and 16.

Withdrawal of the obviousness rejection of claim 33 is therefore respectfully requested.

**C.     REJECTION UNDER  
          35 U.S.C § 103(A) OF CLAIM 21**

Claim 21 was rejected under 35 U.S.C. § 103 as being unpatentable over the Hommel reference, in view of the Higashi reference, in further view of U.S. Patent Application No. 2005/0082108 ("Husain").

**CLAIM 21**

Claim 21 depends from claim 19 and is therefore allowable for the same reasons as claim 19, since the secondary "Husain" reference does not cure -- and is not asserted to cure -- the critical deficiencies of the "Hommel" and "Higashi" references. It is therefore respectfully requested that the obviousness rejection for claim 21 be withdrawn.

Withdrawal of the rejection of claim 21 is therefore respectfully requested.

As further regards all of the obviousness rejections, the Examiner has not provided specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully submitted that, although it has been previously requested, the Examiner has not provided an affidavit and/or published information concerning these assertions. The § 103 rejections were apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, but no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence)**

**that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Final Office Action offers no evidence, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

The Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that it simply does not describe the features discussed above of the rejected claims.

As still further regards all of the obviousness rejections of the claims, it is respectfully submitted that a proper *prima facie* case has not been made in the present case for obviousness, since the Answer and the Office Actions to date never made any proper findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such proper showings by the Answer, the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and the Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, claims 13 to 35 are allowable and the rejections should therefore be reversed.



**CONCLUSION**

In view of the above, it is respectfully requested that the rejections of claims 13 to 35 be reversed, and that these claims be allowed as presented

Dated: \_\_\_\_\_

*8/12/2009*

Respectfully submitted,

By: \_\_\_\_\_

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**CLAIMS APPENDIX**

1-12. (Canceled).

13. A torque control element for a steering system in a motor vehicle, for controlling a steering device, comprising:

at least two electrical units; and

power supply units, each of the electrical units being assigned a respective one of power supply units, and each being connected via at least one fuse, wherein the at least two electrical units operate independently of one another.

14. The torque control element as recited in claim 13, wherein at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other.

15. The torque control element as recited in claim 14, wherein the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit.

16. The torque control element as recited in claim 14, wherein at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit.

17. The torque control element as recited in claim 13, wherein the torque control element is a manual-torque control element for at least one of controlling and monitoring a steering handle.

18. The torque control element as recited in claim 13, wherein the torque control element is a wheel-torque control element for at least one of controlling and monitoring at least one steered vehicle wheel.

19. A steering system, comprising:

a first and a second torque control element, each of the first and second torque control elements including at least two electrical units; and

power supply units, each of the electrical units being assigned a respective one of power supply units, and each being connected via at least one fuse;

wherein the first torque control element is a manual-torque control element for a steering handle, and the second torque control element is a wheel-torque control element for at least one steered vehicle wheel.

20. The steering system as recited in claim 19, wherein the steering handle and the at least one steered vehicle wheel are connected to each other via an electronic controlled system.

21. The steering system as recited in claim 20, wherein the steering system makes a mechanical coupling of the steering handle to the steered vehicle wheels available in the event the electronic controlled system fails.

22. The steering system as recited in claim 19, wherein all electrical units are accommodated in a single housing.

23. The steering system as recited in claim 19, wherein the electrical units of each torque control element are accommodated in one housing.

24. The steering system as recited in claim 19, wherein each of the electrical units is accommodated in a separate housing.

25. The steering system as recited in claim 19, wherein at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other.

26. The steering system as recited in claim 25, wherein the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit.

27. The steering system as recited in claim 25, wherein at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit.

28. The steering system as recited in claim 19, wherein the torque control element is a manual-torque control element for at least one of controlling and monitoring a steering handle.

29. The steering system as recited in claim 19, wherein the torque control element is a wheel-torque control element for at least one of controlling and monitoring at least one steered vehicle wheel.

30. The steering system as recited in claim 19, wherein:

at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other,

the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit, and

at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit.

31. The steering system as recited in claim 30, wherein the torque control element is a manual-torque control element for at least one of controlling and monitoring a steering handle.

32. The steering system as recited in claim 30, wherein the torque control element is a wheel-torque control element for at least one of controlling and monitoring at least one steered vehicle wheel.

33. The torque control element as recited in claim 13, wherein:

at least one of the electrical units includes a processing unit and an output-stage unit which cooperate with each other,

the processing unit and the output-stage unit of at least one of the electrical units are connected in each case via one of the fuses to the power supply unit assigned to the electrical unit, and

at least one sensor configured to monitor a steering device is assigned to the processing unit, and at least one actuator configured to control the steering device is assigned to the output-stage unit.

34. The torque control element as recited in claim 33, wherein the torque control element is a manual-torque control element for at least one of controlling and monitoring a steering handle.

35. The torque control element as recited in claim 33, wherein the torque control element is a wheel-torque control element for at least one of controlling and monitoring at least one steered vehicle wheel.



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EVIDENCE APPENDIX

Appellants have not submitted any evidence pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, and do not rely upon evidence entered by the Examiner.

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RELATED PROCEEDINGS INDEX

There are no interferences or other appeals related to the present application.